

REMARKS

This is a full and timely response to the outstanding final Office Action mailed February 24, 2005. Reconsideration and allowance of the application and pending claims are respectfully requested.

Claim Rejections - 35 U.S.C. § 103(a)

As was noted in the previous Response, each of Applicant's claims has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Johnston, et al. ("Johnston," U.S. Pub. No. 2003/0048487) in view of one or more other references. Because the Johnston reference issued after Applicant's filing date, the Johnston reference can only qualify as prior art as to Applicant's claims under 35 U.S.C. § 102(e).

The Johnston reference is not "by another" under 35 U.S.C. § 102(e) because the subject matter of the Johnston reference and Applicant's claimed inventions were owned by the same legal entity (i.e., the Hewlett-Packard Company) or were subject to an obligation of assignment to that legal entity when the inventions were made. In such a case, the cited reference may not be used against the Applicant's claims under 35 U.S.C. § 103. *See* 35 U.S.C. § 103(c) ("Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.").

In response to Applicant's identification that the Johnston reference was owned by the same legal entity or was subject to an obligation of assignment to that legal entity when the inventions were made, the Examiner argues "the claimed invention was not

subject to an obligation of assignment. Assignment to the Hewlett-Packard Company was recorded on February 11, 2002, after the time the invention was made.”

Applicant respectfully submits that the Examiner is misinterpreting the law. As of the date that the assignment was signed in the instant case, the invention was “assigned” to Hewlett-Packard Company (“HP”). That the assignment document was not executed until February 11, 2002 does not, however, mean that the inventors were not “under an obligation” to assign. To the contrary, the inventors were and are obligated as part of their employment at HP to assign the inventions they develop for HP.

Applicants respectfully submit that the statement provided by Applicant as to the assignment or obligation to assign in the previous Response was sufficient to remove Johnston as a reference that can be applied against Applicant’s claims. Section 706.02(l) of the Manual of Patent Examining Procedure (MPEP) specifies the requirements as to establishing common ownership and removing a reference in this situation. Section 706.02(l)(2)(II) provides, in part (emphasis added):

It is important to recognize just what constitutes sufficient evidence to establish common ownership at the time the invention was made. The common ownership must be shown to exist at the time the later invention was made. A statement of present common ownership is not sufficient. *In re Onda*, 229 USPQ 235 (Comm’r Pat. 1985).

The following statement is sufficient evidence to establish common ownership of, or an obligation for assignment to, the same person(s) or organizations(s):

Applications and references (whether patents, patent applications, patent application publications, etc.) will be considered by the examiner to be owned by, or subject to an

obligation of assignment to the same person, at the time the invention was made, *if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person.*

See "Guidelines Setting Forth a Modified Policy Concerning the Evidence of Common Ownership, or an Obligation of Assignment to the Same Person, as Required by 35 U.S.C. 103(c)," 1241 O.G. 96 (December 26, 2000). The applicant(s) or the representative(s) of record have the best knowledge of the ownership of their application(s) and reference(s), and their statement of such is sufficient evidence because of their paramount obligation of candor and good faith to the USPTO.

The statement concerning common ownership should be clear and conspicuous (e.g., on a separate piece of paper or in a separately labeled section) in order to ensure that the examiner quickly notices the statement. Applicants may, but are not required to, submit further evidence, such as assignment records, affidavits or declarations by the common owner, or court decisions, *in addition to* the above-mentioned statement concerning common ownership.

For example, an attorney or agent of record receives an Office action for Application X in which all the claims are rejected under 35 U.S.C. 103(a) using Patent A in view of Patent B wherein Patent A is only available as prior art under 35 U.S.C. 102(e), (f), and/or (g). In her response to the Office action, the attorney or agent of record for Application X states, in a clear and conspicuous manner, that:

"Application X and Patent A were, at the time the invention of Application X was made, owned by Company Z."

This statement alone is sufficient evidence to disqualify Patent A from being used in a rejection under 35 U.S.C. 103(a) against the claims of Application X.

In view of the above, it is clear that Applicant's previous statement concerning the assignment or obligation to assign was sufficient to establish common ownership and, therefore, remove the Johnston reference. To ensure that the statement is "conspicuous" enough, Applicant reiterates the evidence as to common ownership in Appendix A, which is attached to the present Response.

In view of the foregoing, and Appendix A, Applicant respectfully submits that Johnston may not be properly cited against Applicant's claims under 35 U.S.C. §103. Applicant therefore requests that the rejections, and the final status of the examination of the present application, be withdrawn.

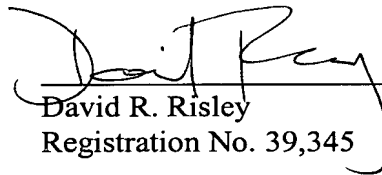
Claims 17-20

In the previous Office Action, Applicant alleged that the Examiner did not specifically reject claims 17-20. Applicant would like to apologize for this error. Applicant's representative now realizes that Applicant's representative was working from a copy of the Office Action that was missing page 17.


CONCLUSION

Applicant respectfully submits that Applicant's pending claims are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested. If, in the opinion of the Examiner, a telephonic conference would expedite the examination of this matter, the Examiner is invited to call the undersigned attorney at (770) 933-9500.

Respectfully submitted,


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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to: Mail Stop AF, Assistant Commissioner for Patents, Alexandria, Virginia 22313-1450, on

April 18, 2005

Signature

APPENDIX A: Statement of Common Ownership

Applicant notes for the record that the present patent application (Serial No. 10/005,583) and the Johnston reference (U.S. Pub. No. 203/0048487) were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same legal entity, namely, the Hewlett-Packard Company. In view of this common ownership, and further in view of the fact that the Johnston reference is being applied under 35 U.S.C. 102(e)/103, Applicant respectfully asserts that the Johnston reference is not properly citable against Applicant's claims. Applicant therefore respectfully requests that the rejections under 35 U.S.C. 103 be withdrawn.